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| 10/613,407 | 07/03/2003 | Curtis Reese | 100204991-1 | 4477 |

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| EXAMINER |
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SAFAIPOUR, HOUSHANG

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| ART UNIT | PAPER NUMBER |
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2625

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01/04/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/613,407

Applicant(s)

REESE ET AL.

Examiner

Houshang Safaipoor

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8-11,13,14,18-20,22,25-27,29,32,33 and 35 is/are rejected.
- 7) ☒ Claim(s) 3,4,6,7,12,15-17,21,23,24,28,30,31,34 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Declaration under 35 CFR 1.131: Ineffective

The declaration filed on September 20, 2007 has been considered but is ineffective to overcome the Seki and Otsuka references. Although the evidence submitted establishes conception, it fails to establish;

- a) diligence from a date prior to the date of reduction to practice of the above references to either a constructive reduction to practice or an actual reduction to practice .
- b) applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the above references. Please refer to MPEP 715 and other related sections for details.

For the reasons stated, examiner maintains his previous rejection:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5, 8, 9-11, 13, 18-20, 25-27, 29, 32, 33 and 37 rejected under 35 U.S.C. 103(a) as being unpatentable over Seki et al. (US 2003/0048484, and further in view of Otsuka (US 2003/0203744).

Regarding claim 1, Seki discloses a method for sending a facsimile (fax) comprising the following:

requesting the user to enter a facsimile number as the destination. Seki does not explicitly disclose selecting, by a user, a phone number for a fax destination from a database residing on a handheld device. Otsuka discloses a cellular phone 3 equipped with an address book in order for the user to select a name of a communication destination including the FAX number from the address book (page 3, [0032-0034]). Therefore it would have been obvious to a person of ordinary skill in the art to include this option, introduced by Otsuka, in the cell phone disclosed by Seki in order to conveniently select the FAX destination;

sending the phone number from the handheld device to a fax machine via wireless communication (page 5, [0066] lines 15-18); and

sending a fax transmission by the fax machine to the fax destination (page 5, [0070], lines 5-10).

Regarding claim 2, Seki discloses a method as in claim 1, wherein before selecting the phone number, the method includes the following:

loading, by the user, a document into the fax machine (facsimile machines 1 & 2, [0053] and [0061]);

establishing communication between the fax machine and the handheld device [0063];
and

sending a command, by the fax machine to the handheld device, requesting the handheld device to prompt the user for a fax number [0066].

Regarding claim 5, Seki discloses transmitting both the entered FAX number and the forwarding command. Seki does not explicitly disclose sending additional information stored in the data base residing on the handheld device. Otsuka discloses such a feature [0033].

Regarding claim 8, Seki discloses a method as in claim 1 wherein sending the phone number from the handheld device to the fax machine includes the following: sending an initiate fax command along with the phone number [0066].

Regarding claims 9, 13, 18, 25, 32 and 37, Seki discloses a method as in claim 1 wherein the handheld device is one of the following: a cell phone [0052].

Regarding claims 10, 19, 26 and 33, Seki discloses a fax machine comprising:
a document input ([0061] discloses a scanner for reading an image from the original.
Otsuka also discloses a MFP2 with a document feeder [0073]);
a wireless communication block [0063]; and
a controller, the controller, detects that a user has loaded a document into the fax machine, and attempts to use the wireless communication block to establish communication with a handheld device, and after establishing communication, receives from the handheld device a fax number for a fax destination [0066 and 0070].

Regarding claims 11, 20 and 27, Seki discloses a fax machine as in claim 10 wherein the fax machine, upon receiving the fax number from the handheld device, sends a facsimile transmission to the fax destination [0066].

Regarding claim 29, please refer to the discussions under claims 1 and 8.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 14, 22 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuka (US 2003/0203744).

Regarding claims 14, 22 and 35, Seki discloses a handheld device comprising:

a display [0032];

a memory in which is stored a database that includes phone numbers [0032-0033]; and

a wireless communication block [0034], wherein the handheld device uses the wireless communication block to establish communication with a fax machine and in response to a user selecting a phone number from the database and a fax option, the wireless communication block sends a fax command and the phone number to the fax machine[0061, 0063, 0073 and 0074].

Allowable Subject Matter

5. Claims 3, 4, 6, 7, 12, 15-17, 21, 23, 24, 28, 30, 31, 34 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412.

The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Houshang Safaipoor
Patent Examiner
December 14, 2007

